UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,987	02/09/2001	Sun Ming Lieu	020004-000720US	2255

20350	7590	02/16/2005

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EXAMINER
MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Application No.	Applicant(s)
09/780,987	LIEU ET AL.

	Examiner	Art Unit	
Office Action Summary	Steven B. McAllister	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _16 September 2004_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,10-13,22,30,39,48-50,59-68,70-80,82-92 and 94-97_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1,10-13,22,30,39,48-50,59-68,70-80,82-92 and 94-97_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _2/2/2004_.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/16/2004 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 10-13, 59-68, 70, and 95-97 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed methods do not recite any technological element practicing the method within the body of the claims (e.g., that a computer performs the "determining" step, etc.).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,10-13, 22, 30, 39, 48-50, 59-68, 70-80, 82-92, 94-97 are rejected under

35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out

and distinctly claim the subject matter which applicant regards as the invention.

The independent claims recite determining purchasable units "using" or "based

upon" the "first information". But, it is not clear whether, the first information includes all

recited information and it is not clear whether all information is used during the

determination.

Claim 97 recites "a subset of vendors that have exclusive right to the first generic

item". However, it is unclear what the right to the item means. For instance, it could be

right to buy, right to sell, or right to have it's brand listed in the resultant shopping list.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 10-13, 39, 48-50, 59-68, 70, 83-92, and 94-97 are rejected under 35

U.S.C. 103(a) as being unpatentable over Treyz et al (6,587,835) in view of Bado et al

(4,703,423) and Shilcrat (5,963,948).

Bado shows receiving information identifying a first project (e.g., a menu or

recipe); storing information identifying a plurality of generic items; information identifying

at least one attribute of the generic items, e.g., that it is associated with French cuisine,

or the type of ingredient, such as fresh (Fig. 8); and information identifying hierarchical

relationships between one or more items (e.g., that one item is a component of a

particular recipe); determining a plurality of purchasable units using the information,

each purchasable unit having a brand name and an amount associated with it. Bado

does not explicitly show storing information identifying one or more substitute generic

items, or that the purchasable units have prices associated with them. Shilcrat shows

storing information on substitutable items. It would have been obvious to one of

ordinary skill in the art to modify the method of Bado by storing this information in order

to provide alternative items. Treyz shows purchasable items having a price associated

with the item (e.g., Fig. 28). It would have been obvious to one of ordinary skill in the art

to further modify the method of Bado by having a price associated with the purchasable

units in order to provide information needed make the purchasing decision.

As to claim 39, it is noted that the combination of Bado in view of Treyz and

Shilcrat show the claimed code since the claimed functionality is performed

automatically in the combination via such code.

As to claims 62-65, it is noted that Bado shows scaling of the recipe in the

system to determine quantities needed.

As to claims 67, 68, it is noted that Bado shows selecting as purchasable units

items from a subset of vendors, comprising items from a brand sponsor.

As to claim 95 and 96, it is noted that Bado in view of Treyz and Shilcrat

additionally show a hierarchical relationship between a first and second generic item,

the second being a specialization of the first (e.g., Treyz shows a generic item of "soups

and canned foods" stored in the database and "chicken soup" as type, or specialization; of the first item (see e.g., Fig. 94)).

Alternatively, it does not explicitly show the stored hierarchical arrangement claimed. However, it is notoriously old and well known in the art to store items such as "cheese" and provide such a hierarchical relationship to an entry such as "Swiss cheese". It would have been obvious to one of ordinary skill in the art to further modify the method of Bado by doing so in order to provide an orderly framework for a browse mechanism.

As to claim 97, it is noted that Bado in view of Treyz and Shilcrat additionally show a hierarchical relationship between a first and second generic item, the second being a specialization of the first (e.g., Treyz shows a generic item of "soups and canned foods" stored in the database and "chicken soup" as type, or specialization; of the first item (see e.g., Fig. 94)). It further shows determining a subset of vendors that have an exclusive right to the generic item, and selecting the purchasable unit from that subset of vendors.

Alternatively, it shows all except the stored hierarchical arrangement claimed. However, it is notoriously old and well known in the art to store items such as "cheese" and provide such a hierarchical relationship to an entry such as "Swiss cheese". It would have been obvious to one of ordinary skill in the art to further modify the method of Bado by doing so in order to provide an orderly framework for a browse mechanism.

As to claims 22, 30,71-80, 82, Bado shows a computer system capable of receiving information related to a project; capable of storing all recited stored information, determining a plurality of purchable units using the first information; and communicating the information identifying the purchasable units. It does not show that the system uses two computers in a client –server releationship; or that it stores substitution information. Shilcrat shows substitution information. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Bado to allow storage of this information in order to provide alternatives. Treyz et al show the client-server architecture. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of Bado by using the client-server architecture taught in Treyz in order to allow information to be retrieved independent of location in the store.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.
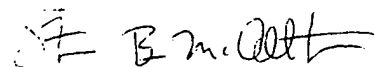
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven B. McAllister

STEVE B. MCALLISTER
PRIMARY EXAMINER